UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,235	11/07/2001	Jennifer L. Lee	55393US011	1507

32692 7590 12/08/2003

3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL, MN 55133-3427

EXAMINER	
BERMAN, SUSAN W	

ART UNIT	PAPER NUMBER
1711	

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/008,235	LEE ET AL.	
	Examiner	Art Unit	
	Susan W Berman	1711	

-- Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 September 2003* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-63* is/are pending in the application.

4a) Of the above claim(s) *1-7 and 28-63* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *8-27* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *5 pages* .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Election/Restrictions

Applicant's election of Group II, claims 8-27, and the ultimate species of aliphatic urethane di(meth)acrylate as the oligo/resin and isobornyl (meth)acrylate as the high Tg monomer is acknowledged. It is noted that applicant has not elected an ultimate species of reactive diluent since no species of adhesion promoting component nor species of multifunctional monomer has been selected.

Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 1-7 and 28-63 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species of the claimed invention, there being no allowable generic or linking claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 8-13, 15-22 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by WO 98/27171. See page 6, line 12, to page 7, line 2 and Example 7. WO '171 discloses compositions comprising an aliphatic acrylic oligo/resin and combinations of reactive acrylate monomers to provide the desired combination of properties. WO '171 teaches the functions of the reactive acrylate monomers disclosed on page 6. Although WO '171 does not specifically mention combining a high Tg component, an adhesion-promoting component and a multifunctional monomer, Example 7 discloses a composition wherein monomers having these properties are combined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 14 and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 98/271171. Example 7 in WO '171 discloses a composition wherein the weight percents of components in the combination of reactive monomers are within the ranges set forth in the instant claim. WO '171 discloses tetrahydrofurfuryl acrylate and ethoxyethoxyethyl acrylate as two of the 6 particularly preferred monomers.

With respect to claim 14, It would have been obvious to one skilled in the art at the time of the invention to determine the required weight percents of different kinds of monomers required to provide the desired combination of properties from the disclosure of WO '171. WO '171 teaches that mixtures and amounts of the monomers can be varied to provide the final composition with the desired combination of properties. Therefore, One of ordinary skill in the art at the time of the invention would have been motivated by a reasonable expectation of success of providing a composition with a desired combination of properties, as taught by WO '171. The data for the examples in the instant specification has been considered. There is no comparative evidence of record to show unexpected results commensurate in scope with the instant claims. See the weight ratios "H:E:I" in Tables 1 and 3.

With respect to claims 26 and 27, It would have been obvious to one skilled in the art at the time of the invention to employ a mixture of tetrahydrofurfuryl acrylate and ethoxyethoxyethyl acrylate in the compositions disclosed by WO '171. WO '171 provides motivation by teaching these specific monomers among 6 monomers disclosed as being particularly preferred for use in the disclosed compositions. WO '171 also teaches that mixtures and amounts of the monomers can be varied to provide the final

composition with the desired combination of properties. Therefore, One of ordinary skill in the art at the time of the invention would have been motivated by a reasonable expectation of success of providing a composition with a desired combination of properties, as taught by WO '171.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 8-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,534,128. Although the conflicting claims are not identical, they are not patentably distinct from each other because the components of the compositions meeting the definitions set forth in the claims can be the same components although the definitions are not identical. The oligomers set forth in the claims of US '128 are aliphatic urethane acrylate oligomers. The radiation curable reactive diluent set forth in the claims of US '128 considered in view of the disclosure of the components providing the reactive diluent comprises the same components as are set forth in the instant claims.

Claims 8-27 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6,558,753. Although the conflicting claims are not identical, they are not patentably distinct from each other because the components of the compositions meeting the definitions set forth in the claims can be the same components although the

definitions are not identical. The oligo/resin is set forth in the claims of US '753 and in the instant claims. The radiation curable reactive diluent set forth in the claims of US '753 considered in view of the disclosure of components providing the reactive diluent comprises the same components as are set forth in the instant claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Carlson et al (6,534,128), Caiger et al (6,114,406), Smith (6,326,419), WO 98/27171 and WO 99/29788.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susan W Berman whose telephone number is 703 308 0040. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on 703 308 2462. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0661.

Susan Berman

Susan W Berman
Primary Examiner
Art Unit 1711

SB
11/1/03